

REQUEST FOR RECONSIDERATION

The rejection of claims 1, 4, and 5 under 35 U.S.C. § 102(b) as anticipated by XP 00227868 (XP '686) in view of the ASM Handbook: Vol. 2; and the rejections of claims 1, 4, and 5 under 35 U.S.C. § 103(a) as being obvious over XP '686 in view of the ASM Handbook: Vol. 2 and of claims 17-18 as obvious over XP '686 are traversed.

Regarding XP '686, the Office emphasizes in the rejection and the remarks that the reference allegedly recites that the “teaches that the formation of a thin film is optional” at column 1 of the reference. (Present Office Action at page 2, paragraph 2 and 6, paragraph 8). (Emphasis in original). However, Applicants note that the reference does not recite any such language whatsoever.

To the contrary, the reference directly recites that “**Corrosion resistance. Depends on the formation of a protective oxide layer.**” (Column 1, lines 28-29 of the reference). (Emphasis added). In other words, the protection of the titanium is dependent on the formation of a protective oxide layer. Moreover, the reference does not suggest or indicate that corrosion resistance is not important, and that therefore a protective oxide layer is not formed. Further, there is no recitation whatsoever of any exact degree of formation or non-formation of the layer. The reference only recites that the layer “becomes darker and thicker with increasing time and temperature.” (Column 2, lines 2-4 of the reference). As such, the reference indicates that a protective oxide layer is clearly present, but a quantitative measurement of thickness is not a concern for the formation/properties of the alloy.

Therefore, the reference clearly cannot anticipate the present claims.

Applicants note that the Office indicates that the based on the composition of the titanium alloy in the reference and the limited disclosure of the ASM Handbook that the surface oxide feature of the claimed is described in the reference. However, Applicants point out these allegations are merely conclusory remarks, based on improper hindsight of the

present specification, since the Office has not shown *how* or *why* it would be advantageous to limit the degree of forming such a layer. Applicants note that support for such an allegation must be found in a reference itself, in which the references do not provide any such support.

Therefore, the claimed invention is novel and unobvious over references.

Withdrawal of the rejection is requested.

The rejection under 35 U.S.C. § 103(a) of claims 1, 4, 5, 17, and 18 as being obvious over JP 09-003573 (JP '573) in view of JP '234 is traversed.

Regarding JP '573, the Office continues to selectively point out that the reference describes, *inter alia*, 0.01 -0.06% Fe and does not describe the presence of Co or Nb. However, Applicants note that it is improper for the Office to selectively pick and choose embodiments from the reference to defeat patentability, without considering the reference's disclosure as whole. Namely, the Office has not considered that the present invention and the disclosure of the reference differ completely on what is meant by "pure titanium".

In the reference, the composition for "pure titanium" is defined as "restricting Fe, O, nickel, and the amount of Cr(s) which are contained in pure titanium to [a specific] moderate range." (Paragraph [0018] of the reference). In fact, as pointed out in paragraphs [0021] through [0024] and Example 1, the content and crystal grain size of all of these elements are *equally* important factors for providing the "pure titanium." Moreover, as shown by the entirety of the reference's disclosure, there is no description or suggestion that "pure titanium" is defined by merely the presence of Fe and/or the absence of Co or Nb.

In contrast, the composition for "pure titanium" in the present invention is defined as follows: "[t]he term 'pure titanium' used herein signifies a substance containing Fe, Nb and Co in contents not exceeding the specified Fe, Nb and Co contents, inevitable impurities, and Ti as the remainder." (Page 8, lines 4-7 of the present specification; see also claim 1). (Emphasis added). The specified Fe, Nb and Co contents are defined in the specification and

the presents claims as “an Fe content of 0.08% by mass or below, a Nb content of 0.02% by mass or below, and a Co content of 0.02% by mass or below.” (Present claim 1).

Applicants note that so-called “moderate ranges” or any such range for the content and grain size of Ni and Cr are clearly not recited as factors in the above-definition nor in any of the present claims.

Moreover, Applicants note that the Office has not provided or identified any evidentiary support for selectively modifying the reference to exclude any content/grain size described therein. It is noted that JP ‘234 describes the formation of an oxide on a titanium alloy. However, there is no indication that such a formation is advantageous for any and every type of titanium alloy.

Further, it is noted that the Office alleges that motivation for formation of such an alloy would be advantageous to prevent discoloration. (Present Office Action at page 4, paragraph 6). However, JP ‘573 clearly recites that an optimum “**color tone** was obtained” by the specific composition, i.e., the moderate ranges for the content and grain sizes of the elements mentioned above. (Paragraph [0018] of the reference; see also Example 1 and the paragraph [0045] which points out the desired amount of gloss obtained). (Emphasis added). As such, the Office clearly has not provided any evidence or support for maintaining the rejection.

Therefore, for the above additional reason, the claimed invention is novel and unobvious over the JP ‘573 reference.

Withdrawal of the rejection is requested.

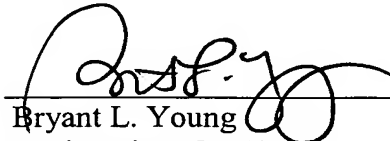
Applicants submit that this application is now in condition for allowance and early notification of such is earnestly solicited.

Application No. 10/800,637
Reply to Office Action of May 31, 2006

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicants' undersigned representative at the below listed telephone number.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon



Bryant L. Young
Registration No. 49, 073

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)